REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-9, 15-23, 29-37, 43-53 are pending, Claims 45-53 having been presently added.

In the outstanding Office Action, Claims 1-9, 15-23, 29-37 and 43 were rejected under 35 U.S.C. § 103(a) as being anticipated by Biorge et al (U.S. Pat. No. 5,806,045) in view of Stein et al (U.S. Pat. No. 5,459,306) and Hertz et al (U.S. Pat. No. 5,754,938). Claim 44 was rejected under 35 U.S.C. § 103(a) as being obvious over Stewart (U.S. Pat. No. 6,452,498) in view of Stein et al and Hertz et al.

Applicants acknowledge with appreciation the courtesy of Examiner Champagne to conduct an interview for this case on May 11, 2004. During the interview, the issues in the outstanding Office Action were discussed as substantially summarized herein.

Independent Claims 1, 3, 15, 17, 29, and 31 define that a targeted advertisement is selected and electronically delivered to a consumer, based on a purchase behavior classification without providing to an advertiser the purchase history of the consumer. Applicants' representative pointed out that Stein et al, cited in the Office Action for its teaching of purchase behavior classification, do share the purchase history of the consumer to the host computer 13 that determines the promotions (i.e., the advertisements).[1] Hence, Stein et al teach away from the claimed invention and do not disclose or suggest selecting a targeted advertisement based on a purchase behavior classification ***without providing to an advertiser a purchase history of the consumer***, as defined in the independent claims.

Indeed, Examiner Champagne indicated on the Interview Summary Sheet apparent agreement on this point.

[1] Stein et al, col. 4, line 60, to col. 5, line 12.

Regarding Hertz et al, Applicants' representative pointed out during the interview that Hertz et al disclose methods to ensure that either (1) the consumer identity is encrypted or (2) the consumer identity is released with consent such as for example in exchange for cash or other consideration. [2] Thus, like Stein, Hertz et al in one of the disclosed alternative solutions (i.e., user permission) teaches away from the claimed invention. M.P.E.P. § 2141.02 requires that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

Thus, it is respectfully submitted that Stein and Hertz et al, when considered as a whole, teach away from the present invention, and thus provide no motivation to one of ordinary skill in the art to make the combination asserted in the outstanding Office Action.

Regarding Claim 44, Claim 44 was rejected under 35 U.S.C. § 103(a) as obvious over Stewart in view of Stein et al and Hertz et al. Applicants respectfully traverse this rejection for the same reasons as given above, i.e., that both Stein et al and Hertz et al teach away from the claimed invention.

Regarding presently pending and previously amended Claims 8, 22, and 36, M.P.E.P. § 2144.04 indicates that it is ***never*** appropriate to rely soley on common knowledge in the art without evidentiary support in the record as the principle evidence upon which a rejection is based. [emphasis added] Since M.P.E.P. § 2141.02 requires that the invention as a whole be considered, Applicants submit that the previously presented amendments to the corresponding independent claims in effect traversed the Official Notice and the grounds for rejection to Claims 8, 22, and 36. Further, as discussed during the interview, when considered as a whole Claim 8 defines a method for selecting and electronically delivering a promotional incentive to the consumer at the first computer based on a purchase behavior classification. The promotional incentive is defined to be provided to comply with a

[2] Hertz et al, col. 5, lines 34-65.

behavioral pattern defined by an amount of at least one specified product to be purchased within a time period by the consumer, and is provided to the consumer without providing to an advertiser the purchase history of the consumer.

Without providing evidentiary support, Applicants can not determine if teachings known in the art regarding the purchase of products within a required time period provide any motivation for combining with Biorge et al, the primary reference. Applicants respectfully request that the evidence that it was common knowledge at the time of the invention for a behavioral pattern to include purchasing the product within a time period be provided in order to assess whether these teachings like Stein et al and Hertz et al also teach away from the claimed invention. Indeed, it is respectfully submitted that it would be expected that the advertiser would not issue a promotional incentive to a consumer requiring a specified product to be purchased within a time period unless the advertiser was aware that the consumer was likely to purchase the product.

The same rationale and request for the basis of the Official Notice is made with regard to Claims 22 and 36.

Finally, new Claims 45-53 define features with regard to cookies, cookie numbers, and the association of cookie numbers with consumer identification.[3] As discussed during the interview, Applicants submit that the prior art does not teach the features defined in these new claims.

Accordingly, Applicants respectfully submit that independent Claims 1, 3, 15, 17, 29, 31, and 53 and the claims dependent therefrom, patentably define over the applied prior art.

[3] Specification, page 12, lines 16-29.

Consequently, in view of the present amendment and in light of the above discussions, the application is believed to be in a condition for allowance. Therefore, an early and favorable action is respectfully requested.

Respectfully submitted,

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